



UNITED STATES PATENT AND TRADEMARK OFFICE

12

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,318	07/25/2001	Oren Globerman		9263

44909 7590 02/10/2005

FENSTER & COMPANY INTELLECTUAL PROPERTY 2002 LTD.
C/O REED SMITH LLP
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

PHILOGENE, PEDRO

ART UNIT PAPER NUMBER

3732

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/890,318	Applicant(s) GLOBERMAN ET AL.	
	Examiner Pedro Philogene	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 and 100-173 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 73-89 and 100-173 is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12, 15, 17, 18, 22, 23, 34-55, 58-60 and 63-72 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 13, 14, 16, 19-21, 24-33, 56, 57, 61, 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8,11,12,15,17,18,22,34,35,37,39,40,42,47-49,58,68 are rejected under 35 U.S.C. 102(b) as being anticipated by Bachmann et al. (5,759,186).

With respect to claim 1, Bachmann et al disclose an apparatus (1) for controlling the deformation of an implant during deployment thereof, comprising a force application mechanism (3) for applying deformation force to the implant, by axial motion of a force applicator against the implant; and a restraint element positioning mechanism; as best seen in FIG.5, that positions a restraining element such that the deformation of the implant is controlled by restraint of the restraining element on allowable deformation; and a synchronizer; as best seen in FIGS.7,8, that synchronizes the motion of the restraining element and the force applicator, to achieve a desired deformation of the implant.; as set forth in column 4, line 15 - column 5, line 5; column 5, line 48 – column 6, line 32, column 6, lines 51-64.

With respect to claims 2-8, 11, 12, 15, 17,18,22,34,35,37,39,40,42,47-49,58,68, Bachmann et al discloses all the limitations; as set forth in column 4, line 15 - column 5, line 5; column 5, line 48 – column 6, line 32, column 6, lines 51-64.

Claims 1, 23,38, 41, 47-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Beyar et al. (5,782,838).

With respect to claim 1, Beyar et al disclose an apparatus (1) for controlling the deformation of an implant during deployment thereof, comprising a force application mechanism, as best seen in FIGS.1,5-9, for applying deformation force to the implant, by axial motion of a force applicator against the implant; and a restraint element positioning mechanism; as best seen in FIG.4, that positions a restraining element such that the deformation of the implant is controlled by restraint of the restraining element on allowable deformation; and a synchronizer; as best seen in FIGS5-9, that synchronizes the motion of the restraining element and the force applicator, to achieve a desired deformation of the implant.; as set forth in column 1, line 66 - column 2, line 29; column 3, lines 12-67.

With respect to claims 23,38, 41, 47-55, Beyar et al discloses all the limitations; as set forth in column 1, line 66 – column 2, line 29; column 3, lines 12-67.

Claims 1, 34-37,69-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Lenker et al. (5,683,451).

With respect to claim 1, Lenker et al disclose an apparatus (30) for controlling the deformation of an implant during deployment thereof, comprising a force application mechanism, as best seen in FIGS.1-10, for applying deformation force to the implant, by axial motion of a force applicator against the implant; and a restraint element positioning mechanism; as best seen in FIG.2, that positions a restraining element such that the deformation of the implant is controlled by restraint of the restraining element on allowable deformation; and a synchronizer; as best seen in FIG. 2, that synchronizes the motion of the restraining element and the force applicator, to achieve a desired

deformation of the implant.; as set forth in column 6, lines 29-60; column 7, line 6 – column 8, line 10; column 8, line 54 – column 9 line 41; and, as best seen in FIGS. 1-10.

With respect to claims 34-37, 69-72 Beyar et al discloses all the limitations; as set forth in column 6, lines 29-60; column 7, line 6 – column 8, line 10; column 8, line 54 – column 9 line 41; and, as best seen in FIGS. 1-10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-46, 59, 60, 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachmann et al. (5,759,186).

With respect to claims 43-46, 59, 60, 63-67; it is noted that Bachmann et al did not teach of a force of 20-100 Kg and a restraint having an outer diameter less than 4-7 mm; or an apparatus attached to the patient or the bed; as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to reach the optimum value, since it has been held that discovering an optimum value of an effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Also, the use of a means to attach an apparatus to a patient or a patient's bed is old and well known in the surgical art. As to the implant being a spinal implant for fusing vertebrae, it is nothing more than the intended use of the implant.

Response to Amendment

Applicant's arguments, see remark, filed 12/06/04, with respect to claims 73-89, 172,173 have been fully considered and are persuasive. The rejection of these claims has been withdrawn. However, after further consideration, the indication of allowability of claims 1-72 has been withdrawn. A new rejection follows (see above).

Allowable Subject Matter

Claims 9,10,13,14,16,19-21,24-33,56,57 61,62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 73-89, 100-173, are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
February 08, 2005



PEDRO PHILOGENE
PRIMARY EXAMINER